

REMARKS

This paper is presented in response to the final official action dated February 13, 2008, wherein (a) claims 1-8, 10-12, 14-21, and 23-28 were pending; (b) claims 1, 4, 5, 7, 8, 10-12, 14-18, 21, 23-25, 27, and 28 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,403,605 ("Smith") in view of U.S. Patent No. 5,490,447 ("Giuliano"); (c) claims 2, 3, 6, 19, 20, and 26 were rejected under 35 U.S.C. § 103(a) as obvious over Smith in view of Giuliano and further in view of U.S. Patent No. 4,052,318 ("Krebs").

U.S. Patent No. 6,016,740, upon which this reissue application is based, expired as a result of an unintentional failure to pay the seven and one-half year maintenance fee. A petition to accept unintentionally delayed payment of the seven and one-half year maintenance fee under 37 C.F.R. § 1.378(c), the maintenance fee, and the surcharge under 37 C.F.R. § 1.20(i)(2) are submitted concurrently with this paper.

Reconsideration and withdrawal of the rejections are respectfully requested in view of the following remarks.

Claim Rejections

Independent claims 1, 4, and 21 are directed to a device for filtering espresso-type coffee ground having a size of 0.3 mm or less. Independent claims 7 and 17 are directed to a method of making lower lipids-containing brewed espresso-type coffee. Each of the independent claims recites the combined use of a permanent filter and a paper filter, which effectively removes harmful lipids and coffee grounds that may increase the cholesterol levels in a person drinking the brewed coffee. See claims 1, 4, 7, 17, and 21; and specification, col. 3, lines 62-66. Further, claim 1 recites, in relevant part, that the "permanent filter [has] openings sized to filter out the fine espresso coffee grounds having a size of 0.3 mm or less" Claims 4, 7, 17, and 21 similarly recite "a permanent filter having openings sized to filter coffee grounds having a size of 0.3 mm or less"

Applicant respectfully traverses the obviousness rejections and submits that the applied references fail to establish a *prima facie* case of obviousness. None of the applied references discloses or suggests the combined use of a paper filter and permanent filter having openings sized to filter coffee grounds having a size of 0.3 mm or less, in order to remove harmful lipids from brewed espresso-type coffee. Moreover, as shown below, it is improper to combine the primary reference, Smith, with any reference disclosing or suggesting a permanent filter having openings sized to filter coffee grounds having a size of

0.3 mm or less. Thus, no proper combination of the applied references discloses or suggests each and every limitation of the claims. Accordingly, the applied references and any proper combinations thereof do not establish a *prima facie* case of obviousness.

Specifically, Smith fails to disclose or suggest the combined use of a permanent filter and a paper filter for any reason, much less in order to reduce the lipid content of the brewed coffee. The action mischaracterizes Smith when it states that “while Smith discloses element 44 as a ‘foraminous support’, such functions as a filtering element.” Official Action, page 2. The coffee being filtered in Smith has “a grind with an average particles size within a range from 300 to 850 microns,” while the foraminous support sheet 44 has openings with a diameter of 1 mm to 2.5 mm. Smith col. 3, lines 30-33, and U.S. Patent No. 5,190, 653 (“Herrick”), col. 3, lines 29-30. (Smith expressly incorporates the disclosure of Herrick by reference. See Smith col. 2, lines 66-68, to col. 3, lines 1-2.). The coffee grind particles would pass through the foraminous support sheet 44, thus, the foraminous support sheet 44 does not function as a filtering element within the meaning of the claims, which call for a filter element “sized to filter coffee grounds having a size of 0.3 mm or less” or equivalent language.

Regardless of whether the foraminous support sheet 44 can be characterized as a filter, Smith fails to disclose or suggest a permanent filter having openings sized to filter coffee grounds having a size of 0.3 mm or less. Rather, Smith discloses a foraminous support sheet 44 having openings with a diameter from 1 mm to 2.5 mm. Herrick, col. 3, lines 29-30. Further, Smith expressly teaches that the foraminous support sheet 44 is intended to function as a **support** for a filtering element 42. See Smith, col. 4., lines 38-41. Consistent with this function and the goal of “providing a process for rapidly brewing coffee,” Smith discloses that the foraminous support sheet 44 should contain the maximum open area consistent with strength. Smith, col. 2, lines 14-18; and Herrick, col. 3, lines 22-23. Accordingly, one of ordinary skill in the art would not be motivated to modify Smith to provide for the permanent filter of the claimed invention because such modification would require one to reduce the size of the openings of the foraminous support, which is contrary to the express teachings in Smith that the foraminous support sheet 44 openings have a diameter of 1 mm to 2.5 mm and that the foraminous support sheet 44 contain the maximum open area consistent with strength.

Clearly, Smith teaches away from the invention. As a result, one of ordinary skill in the art would not be motivated to combine Smith with Guiliano or any other reference teaching a filter having openings sized to filter coffee grounds of a size of 0.3 mm or less.

Therefore, a *prima facie* case of obviousness cannot be based in whole or in part on Smith. Claims 1, 4, 7, 17, and 21 are therefore allowable over the applied references.

Claims 2, 3, and 8 depend from independent claim 1; claims 5, 6, and 10-12 depend from independent claim 4; claims 14-16 depend from independent claim 7; claims 18-20 depend from independent claim 17; and claims 23-28 depend from independent claim 21. Claims 1, 4, 7, 17, and 21 are shown above to be allowable, therefore, claims 2, 3, 5, 6, 8, 10-12, 14-16, 18-20, and 23-28 are also allowable.

For the foregoing reasons, it is urged that all claims are of proper scope and form for allowance, and such action is solicited.


This paper is presented in accordance with 37 C.F.R. § 1.116(e) in an effort to place the application in condition for allowance. The arguments presented herein were not and could not have been presented in a prior response because the current action applies an additional, new publication (Guiliano) to support its new 35 U.S.C. § 103(a) rejections of the pending claims. This paper responds to those new rejections. Therefore, consideration and entry of this paper is proper and such action is solicited.

Further, this paper is submitted within two months of the date of the official action in order to take advantage of the advisory action process should the application not be allowed. As this paper is being presented after final rejection, any delay in issuance of the advisory action will prejudice the applicant. Accordingly, a prompt advisory action in reply to this paper is solicited, especially in view of the length of time between issuance of the previous official actions and directive in 37 C.F.R. § 1.176(a) that "[a]pplications for reissue . . . be acted on by the examiner in advance of other applications."

Should the examiner wish to discuss the foregoing, or any matter of form in an effort to advance this application toward allowance, he is urged to telephone the undersigned at the indicated number.

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Respectfully submitted,

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